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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,257	07/11/2001	Steven M. Cohn	2003034-0002	9439

7590 05/21/2004

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,257

Applicant(s)

COHN ET AL.

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION

Response to Amendment

Applicants' "Remarks" filed on February 12, 2004 has been considered with the following effect.

Applicants' amendment to the Specification has been acknowledged.

Applicants' response by virtue of amendment to claim 7 has overcome the Examiner's objection.

Claims 1-8, 12, 13, and 17 have been amended. Claims 1-17 remain pending and an action on merits of these claims follows.

Drawings

The drawings filed on July 11, 2001 are acceptable.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3625

Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,141,653 to Conklin. Conklin discloses the method comprising:

- maintaining a comprehensive online directory of sellers (see at least Figure 1f; col. 19, lines 7-13; col. 19, lines 39-44; col. 19, lines 58-60; col. 32, lines 59-61);
- providing a request for proposal application (see at least col. 20, lines 23-34; col. 25, lines 6-11; col. 25, line 41-col. 26, line 10);
- co-branding the request for proposal application (see at least col. 19, lines 1-6; col. 19, lines 24-27);
- providing an e-commerce infrastructure (see at least col. 15, lines 26-29; Figure 1a);
- marketing a private-label web site of the partner (see at least col. 19, lines 39-57; col. 29, lines 13-47); and
- providing usage and revenue reports (see at least col. 19, lines 10-14; col. 19, lines 39-57; col. 29, lines 13-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,653 to Conklin in view of U.S Patent No. 5,944,769 to Musk et al.

Art Unit: 3625

Regarding claim 1, Conklin discloses an apparatus connecting buyers and sellers of products services comprising:

- a comprehensive directory of companies (see at least Figure 1f; col. 19, lines 7-13; col. 19, lines 39-44; col. 19, lines 58-60; col. 32, lines 59-61);
- a user-maintained database or registered and subscribing companies selected from the comprehensive directory (see at least col. 19, lines 39-44; col. 32, lines 37-43); and
- service-brokering tools for interacting with the directory of companies and user-maintained database of companies (see at least col. 14, lines 11-16), comprising;
 - registering means for buyers and sellers to subscribe to the user-maintained database (see at least col. 19, lines 28-30; col. 19, lines 39-44; col. 20, lines 1-4; col. 20, lines 53-55; col. 32, lines 54-59)
 - contacting means for buyers and sellers to contact subscribing members of the user-maintained database over a network (see at least col. 19, lines 30-38; col. 20, lines 23-34; col. 21, lines 7-12; col. 22, lines 9-29);
 - assigning means denoting a weighted importance to provider characteristics associated with each subscribing buyer and seller (see at least col. 26, lines 33-38; col. 28, lines 59-65; col. 43, line 65 – col. 33, line 6; col. 20, lines 23-34; col. 23, lines 59-67);
 - ordering means for ranking buyers and sellers according to the weighted importance of provider characteristics stored in the user-maintained database (see at least col. 19, lines 58-66; col. 23, lines 59-67); and

Art Unit: 3625

- branding means for defining visual attributes, geometric layouts, graphical layouts, textual layouts, interface elements, and logical design elements that can be used to dynamically generate a branded web site (see at least col. 19, lines 1-6; col. 19, lines 24-27).

However, Conklin does not explicitly disclose the searching based on geographical boundaries. Conklin discloses the collection and analysis of direct email demographic information such as company name, title, and location (col. 19, lines 49-51). Musk, on the other hand, teaches the searching based on geographical boundaries (see at least abstract, col. 1, lines 29-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conklin to include searching based on geographical boundaries, in order to allow a user to look up a business and provide direction to a location (Musk col. 1, lines 12-13 col. 1, lines 19-21).

Regarding claims 2-6, Conklin discloses an internal mechanism for a web server to infer a private label interface; a partner object that can persist and cache the private label interface information; objects that can be used to generate private label interface specific HTML; and a mechanism to publish a pending Partner record to an active record and information (see at least col. 19, lines 1-6; col. 19, lines 24-27; col. 27, lines 34 – col. 28, line 36).

Regarding claims 7 and 12, Conklin discloses an apparatus for connecting buyers and seller of products services comprising;

Art Unit: 3625

- means for sharing requests for proposals, wherein the means for sharing request proposals allows the buyers and seller s to supply, access and response to the request fro proposals (see at least col. 20, lines 23-34; col. 25, lines 6-11; col. 25, line 41-col. 26, line10); and
- means for partner web site branding (see at least col. 19, lines 1-6; col. 19, lines 24-27).

However, Conklin does not explicitly disclose the means of geographical radium searching based on geographical boundaries. Conklin discloses the collection and analysis of direct email demographic information such as company name, title, and location (col. 19, lines 49-51). Musk, on the other hand, teaches the means of geographical radium searching based on geographical boundaries. (see at least abstract, col. 1, lines 29-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conklin to include means of geographical radium searching based on geographical boundaries, in order to allow a user to look up a business and provide direction to a location (Musk col. 1, lines 12-13 col. 1, lines 18-20).

Regarding claims 8 and 13, Conklin discloses a data sharing engine; means for a subscription sales process for authorizing access of the sellers; a request brokering engines; an object catalog manager; and means for a catalog synchronization process (see at least Figure 1f; col. 14, lines 11-16; col. 19, lines 39-44; col. 19, lines 58-60; col. 32, lines 59-61; col. 19, lines 30-38; col. 20, lines 23-34; col. 21, lines 7-12; col. 22, lines 9-29).

Regarding claim 9, Musk discloses a GeoCode table containing data relating latitude and longitude information; a Grouped GeoCode table containing an aggregated form of the data from the GeoCode table; and means for searching (Musk see at least col. 1, lines 29-44; col. 5, lines 54-65; col. 3, line 66- col. 4, line 7).

Regarding claims 10-11, Conklin discloses a partner manage tool; a brand distribution service; a partner branding framework; a web server with software having encapsulating technologies; programming objects; and a template used as a foundation (see at least col. 20, lines 23-34; col. 25, lines 6-11; col. 25, line 41-col. 26, line 10).

Regarding claim 14, Conklin discloses the subscription sales process comprises: navigating to a private labeled interface; clicking a registration hyperlink; selecting a subscription package; building a profile of a company; categorizing the profile; and creating and affiliation between the company and the private labeled interface (see at least col. 19, lines 1-6; col. 19, lines 24-27; col. 27, line 34 – col. 28, line 36).

Regarding claim 15, Musk discloses relating latitude and longitude information to geographic locations; aggregating information relating latitude and longitude to geographic location; normalizing the aggregated information; importing the normalizing information into a database; and searching the database (Musk see at least col. 1, lines 29-44; col. 5, lines 54-65; col. 3, line 66- col. 4, line 7).

Regarding claim 16, Conklin discloses editing a private label interface web site; publishing modification using a brand distribution service; and generating web pages according to branding information (see at least col. 19, lines 1-6; col. 19, lines 24-27; col. 27, line 34 – col. 28, line 36).

Art Unit: 3625

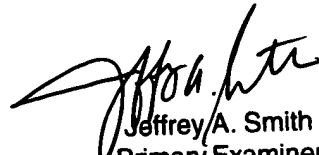
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
May 17, 2004


Jeffrey A. Smith
Primary Examiner